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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/498,515
Filing Date: February 04, 2000
Appellant(s): PAGE ET AL.

Todd C. Adelmann
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 13, 2010 appealing from the Office action

mailed July 19, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

The application was previously submitted to the Board of Patent Appeals and Interferences and the Examiner's rejection was affirmed by the BPAI on November 6, 2007 (Appeal 2007-1333).

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1, 5, 7, 8, 10-12, 17, 18, 20 and 21.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to

be reviewed on appeal. Every ground of rejection set forth in the Office action from which the

appeal is taken (as modified by any advisory actions) is being maintained by the examiner except

for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW

GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the

Appendix to the appellant's brief.

(8) Evidence Relied Upon

6718551	SWIX et al.	04-2004
5822018	FARMER	10-1998
6588015	EYER et al.	07-2003
6698020	ZIGMOND et al.	02-2004

"NDS: NDS' XTV(TM) time shifting technology empowers the viewer and the

broadcaster", M2 Presswire, Sep 10, 1999.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 1, 5, 7, 8, 10-12, 17, 18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Swix et al. U.S. Patent No. 6,718,551, in view of Farmer (US 5,822,018), in

view of Zigmond et al. (US 6,698,020) in view of "NDS: NDS' XTV(TM) time shifting

technology empowers the viewer and the broadcaster", M2 Presswire, Sep 10, 1999, (hereinafter

XTV(TM)) and further in view of Eyer et al. (US 6,588,015).

Regarding claims 1, 7, 8, 11, 12, 17, 18 and 21, Swix teaches selecting video advertising

(e.g. pickup trucks) that has a subject matter relation to the selected video content (e.g. western

movies) requested by the target viewer (see col. 9 line 33 to col. 10 line 34); transferring the

selected video content to the a target viewer device over a first transport system and transferring

the selected video advertising to the target viewer device over a second transport system,

wherein the first transport system uses greater bandwidth for video transfer than the second

transport system (see col. 12 line 21 to col. 13 line 23). Swix teaches delivering bit map or video

advertisements and storing the advertisement in the viewer device and retrieving the

advertisement for insertion in an advertisement slots (see col. 11 line 34 to col. 12 line 60). Swix

teaches q-tone signal indicating the beginning of an advertisement insertion. Farmer teaches the

program material (video and audio) transmitted via transmitting channel (22) and transmitting

the cue tones (signals for insertion point) via channel 23 (see fig. 1, col. 1 lines 37-51, col. 4

lines 25-48, col. 6 lines 49-65, col. 12 lines 51-67). It would have been obvious to one of

ordinary skill in the art at the time of the invention to transmit the signal for the insertion point

over the second channel which is different from the first channel, in order for a local program to

control the insertion point of the local advertisements. Swix teaches the insertion of

advertisement before and after the presentation of a video content, but failed to explicitly teach

interrupting the transferring of the video content in the video stream at the insertion point;

retrieving the selected video advertising from the video storage of the target viewer device;

inserting the selected video advertising into the video stream; resuming the transferring of the

selected video content in the video stream at the insertion point, it is taught in Zigmond (see fig.

3-6, col. 4 lines 15-52, col. 6 lines 13-29, col. 7 lines 1-25 and col. 17 lines 10-32). It would have

been obvious to one of ordinary skill in the art at the time of the invention to store the

advertisement of Swix locally and to interrupt the video and display the select advertisement and

upon termination of the advertisement to resume the transfer of the video content as in Zigmond

in order to individually target the viewer or (household-by-household) as taught in Zigmond (see

col. 7 lines 30-67). Swix does not teach disabling fast-forward capability when the selected video

advertising is displayed. XTV(TM) teaches a set-top-box which provides advertisers with the

ability to totally prevent views from skipping ads. It would have been obvious to one of ordinary

skill in the art at the time of the invention to disable the ability of fast-forward or skip forward in

order to force the subscriber to view the commercials (see page 1). STV(TM) does not explicitly

indicate how ads are skipped. Eyer teaches that it is possible to force subscriber to listen to

certain commercials by disabling the ability to FAST FORWARD or SKIP FORWARD (see col.

7 line 50 to col. 8 line 12 and col. 16 lines 37-54). It would have been obvious to one of ordinary

skill in the art at the time of the invention to disable the fast-forward or skip forward function of

the set-top box of Swix, as taught in Eyer, to provide the advantage of preventing ad skipping

function, as taught in STV(TM).

Regarding claim 5, Swix teaches selecting the video ad based on a viewer profile for the target viewer (see col. 7 line 31 to col. 8 line 2, col. 8 line 66 to col. 9 line 44).

Regarding claims 10 and 20, Swix does not explicitly teach re-displaying the selected video advertisements after rewinding the video content. It would have been obvious for Swix to re-display the same advertising since the advertisement selected is cached at the client set-top box and is inserted into the video stream, locally at a client side, and presented to the viewer.

(10) Response to Argument

Appellant states that the Final Office Action lists dependent claims 7, 8, 11, 17, 18, and 21 in the summary of the rejection (page 2, last ¶). Appellant argues that no discussion of the individual limitations of these claims or explanation of the rejection with respect to these claims is provided.

Claim 1 recites storing the selected video advertising in video storage of the target viewer device and claim 7 recites caching the video advertising using the video storage of the target viewer device. In the Office action Examiner indicated that "Swix teaches delivering bit map or video advertisements and storing the advertisement in the viewer device and retrieving the advertisement for insertion in an advertisement slots (see col. 11 line 34 to col. 12 line 60)". In column 11 lines 34-57, Swix clearly indicated that the target viewer device uses cache to store the advertising. Claim 12 and 17 are also addressed the same way as claim 1 and 7.

Claim 8, which depends on claim 1, recites displaying the selected video content and the selected video advertising to the target viewer. The Office action indicated that Swix teaches selecting video advertising (e.g. pickup trucks) that has a subject matter relation to the selected video content (e.g. western movies) requested by the target viewer (see col. 9 line 33 to col. 10

line 34), which shows that Swix teaches displaying the video content and advertising to the target viewer.

Claim 12 recites the video advertising insertion system comprising: a target viewer device configured to store the selected video advertising in the video storage, transfer the selected video content in the video stream to a display device. Claim 18, which depends on claim 12, recites that the video advertising insertion system of claim 12 further comprising the display device. The Office Action, by addressing the limitation (transfer the selected video content in the video stream to a display device), i.e. by treating the display device as part of the system, also addressed claim 18.

Claim 21 recites the video advertising insertion system of claim 12 further comprising the video-on-demand system configured to receive the request from the target viewer for the selected video content, and in response, transfer the selected video content in the video stream to the target viewer device. This limitation is also addressed by addressing claim 12 which recites "a processing system configured to select video advertising that has a subject matter relation to the selected video content requested by the target viewer... a first transport system configured to transfer the selected video content to the target viewer device. Swix also teaches as claimed in claim 21, the video advertising insertion system comprising the video-on-demand system, (see for example col. 4 lines 39-65, col. 9 lines 45-54) as indicated in Office action.

Regarding the reference Farmer, Appellant asserts that the Farmer target viewer devices are located in the area which exists to the right of Figure 1 entitled "to cable distribution system and subscribers". Appellant argues that only a single transport system exists between Farmer CTV system 20 and the target viewer devices, therefore, it is not possible for Farmer to teach transferring the insertion point to the target viewer device over the second transport system as asserted in the Final Office Action because Farmer does not have a second transport system

which links CTV System 20 to the target viewer devices. Appellant further argues that Farmer timing signals and video content are combined at Switch 25 and transmitted to the target viewer devices over a single **transport system.**

Examiner would like to point out that Swix teaches broadcast server 105 delivers the continuous broadcast program in one channel and delivers other programs and advertisements in other channels. Swix however failed to explicitly teach the q-tones (insertion points) are delivers in other channels (as the other programs or advertisements). Farmer teaches the Earth Station Receiver and Decoder (21), transferring the insertion points (q-tone or cue tones) over the second transport system (over 23), used for transferring the video advertising, (which is different than the transport system used for transferring the video content). Whether a switch and modulator is used before the video content and the video advertisement reaches the target viewer device does not change the fact that the cue tones are transferred to the target view from system 21 via the second transport system (23).

The sole difference between the primary reference and the claimed subject matter is that the primary reference does not disclose the q-tone being transferred over the second transport system. However, as indicated above the second reference, Farmer shows transferring the q-tones over a second transport system was known in the prior art at the time of the invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to transmit the signal for the insertion point over the second channel which is different from the first channel, in order for a local program station to control the insertion point of the local advertisements.

Appellant further argues that the cue tones used in Farmer cannot be analogized to the insertion points of claim 1 because the insertion points comprise data indicating where in the selected video content the selected video advertising is to be inserted. Appellant asserts "(t)he

Farmer cue tones are simply signals which instruct the Ad-Insertion system to perform a specific

function at the immediate time (see Farmer, col. 4, lines 49-51). The cue tones do not contain

information indicating positions within the selected video content. The Farmer Earth

Station Receiver 21 contains the information regarding the timing relationship between

the cue tones and the particular locations within the video content (see Farmer, Fig. 1).

Cue tones are simply electrical signal tones and do not themselves contain data indicating

where within the selected video content advertising should be inserted. Because cue tones do not

contain this type of data, it is erroneous to analogize them to insertion points which comprise

data indicating where in the selected video content the selected video advertising is to be

inserted".

      Examiner would like to remind Appellant that Appellant amended the independent claims

(claims 1 & 12) to include "wherein the insertion point comprises data indicating where in the

selected video content the selected video advertising is to be inserted" (amendment filed

(10/14/08). Appellant indicated the support for the new limitation in the specification in Fig. 2

and page 6 lines 14-18.

      However, Appellant's specification on page 6 lines 14-18 discloses as follows:

> The processing system 211 responds to the request by selecting particular video
> advertising 213 to insert based on the identity of the target viewer 220 and the selected
> video content 201 that is requested by the target viewer 220. **The processing system 211
> 15 also determines insertion points in the selected video content 201 for the selected
> video advertising 213. The processing system 211 transfers the insertion points** to the
> scheduler 212 over either the transport system 202, or the transport system 204 through
> storage 214 and link 215.

Nowhere in the specification is disclosed that the insertion points comprises data

indicating where in the selected video content the selected video advertising is to be inserted

Examiner then rejected the claims under 35 U.S.C. 112, first paragraph (filed 12/11/08).

Appellant argument (filed 3/11/09) to the 112 rejection was as follows:

Claim Rejection under 35 U.S.C. § 112, First Paragraph

> Claims 1 and 12 stand rejected under 35 U.S.C. § 112, first paragraph, for failing
> to comply with the written description requirement. (Page 2 of the Office action.) The
> Office action indicates that the clause "wherein the insertion point comprises data
> indicating where in the selected video content the selected video advertising is to be
> inserted" was not described in the specification in such a way as to reasonably convey to
> one skilled in the relevant art that the inventors had possession of the claimed invention
> at the time the application was filed. (Id.) In referring to page 6, line 25, to page 7, line
> 9, the Office action asserts that "the specification teaches an insertion point where the
> advertisement is to be inserted. In light of applicant's invention the insertion point itself
> indicated that the advertisement is to be inserted in the insertion point. This is different
> than the insertion point including data which indicated where the advertising is to be
> inserted." (Page 3 of the Office action.)

> The Applicant respectfully disagrees with the limited interpretation of the
> specification proffered in the Office action. With respect to Fig. 2, the present
> application indicates that a requested selection of video content 201 is transferred over
> one transport system 202 to a scheduler 212, while advertising selected by the processing
> system 211 in response to the request is transferred over another transport system 204 to
> video storage 214. (See page 6, lines 9-11, 12-14, 19, and 20.) "The processing system
> 211 also determines insertion points in the selected video content 201 for the selected
> video advertising 213. The processing system 211 transfers the insertion points to the
> scheduler 212 over either the transport system 202, or the transport system 204 through
> storage 214 and link 215." (Page 6, lines 14-18; emphasis supplied.) As a result, the
> insertion points may be transported over a transport system 204 different from the
> transport system 202 utilized for transferring the requested selection of video content
> 201, as is set forth in claims 1 and 12. Thus, in that embodiment, the insertion points are
> more than just the points themselves within the video content at which the video
> advertising is to be inserted since the insertion points are transported separately from the
> selected video content 201.

> Further, Fig. 3 of the present application indicates that the insertion points (T1,
> T2 .....TN) may be stored in a viewer profile data structure 330 within the processing
> system 211. (Page 7, lines 5-9.) Thus, the insertion points of Fig. 3 are embodied as data.
> Additionally, "[w]hen the scheduler 212 encounters an insertion point for the selected
> video content 201, the scheduler 212 interrupts the transfer of the selected video content
> 201 and retrieves the corresponding selected video advertising 213 from the video storage
> 214 over the link 215. The scheduler then transfers the selected video advertising 213 to

the television 221 over the link 203." (Page 6, line 27, to page 7, line 1.) Thus, the
insertion points of Fig. 3 indeed "indicat[e] where in the selected video content the
selected video advertising is to be inserted," as set forth in claims 1 and 12.
Thus, in light of the foregoing discussion, the Applicant contends that claims 1 and 12 are
fully supported by the present application, and thus respectfully requests that the 35
U.S.C. § 112, first paragraph, rejection of claims 1 and 12 be withdrawn.

Based on Appellant's argument i.e., the insertion points are more than just the points

themselves within the video content at which the video advertising is to be inserted **since the**

insertion points are transported separately from the selected video content 201, Examiner

withdrew the 35 U.S.C. § 112, first paragraph.

Based on the understanding that if insertion points are to be transported separately, then

the insertion points comprises of data, the Examiner provided a reference that discloses insertion

points that are transported separately. The insertion point is treated to consist of data just because

it is transported separately. Since the Farmer reference transports the cue tones separately, at

least by this definition the cue tones are considered to consist of data.

According to Webster dictionary the definition of "data" is information outputted by a

sensing device or organ that includes bother useful and irrelevant or redundant information and

must be processed to be meaningful **or** information in numerical form that can be digitally

processed.

The definition of a "signal" is "a detectable physical quantity or impulse (as a voltage,

current, or magnetic field strength) by which messages or information can be transmitted".

Therefore, the signal of Farmer includes a message or information indicating where the

ad is to be inserted.

Appellant also argues that the combination of Swix and Farmer is improper. Appellant argues the combination for combining Farmer stated in the Final Office action is not taught in or supported by Farmer and would not lead one to use Farmer.

Examiner points out that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and KSR International Co. v. Teleflex, Inc., 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, ordinary skill in the art would have used the transport system used for the continuous broadcast program to transport the insertion point, as in Swix, or the transport system used for the advertisement, as in Farmer, in order to provide the local program station to control the transport of the insertion points.

Appellant also argue that the purported motivation for combining Zigmond with Swix "in order to individually target the viewer or (household-by-household) as taught in Zigmond" is improper for two independent reasons. Appellant asserts that first, Swix accomplishes the purported motivation without modification and second, modifying Swix in this manner improperly defeats Swix's principle of operation.

Examiner points out that the only reason that Zigmond was applied is because Swix does not explicitly disclose the interrupting of the video content at the insertion point, to insert the advertisement. However, it does not mean that in Swix the video is not interrupted in order to insert the advertisement. Since Zigmond shows interrupting a video at an insertion points to insert an advertisement was known in the prior art at the time of the invention, it would have

been obvious to one of ordinary skill in the art at the time of the invention to know that the Swix video would also be interrupted at the insertion point to insert the advertising.

In response to applicant's argument that modifying Swix as in Zigmond system would defeat its principle of operation, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

YR
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